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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/909,042 | 07/19/2001 | Kenichiro Matsuura | B588-021 | 8469 |
| 26272 | 7590 | 06/13/2005 | EXAMINER | |
| COWAN LIEBOWITZ & LATMAN P.C. JOHN J TORRENTE 1133 AVE OF THE AMERICAS 1133 AVE OF THE AMERICAS NEW YORK, NY 10036 | | | PRIETO, BEATRIZ | |
| | | ART UNIT | PAPER NUMBER | |
| | | 2142 | | |
| DATE MAILED: 06/13/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/909,042 | MATSUURA ET AL. | |
| | Examiner | Art Unit | |
| | Prieto Beatriz | 2142 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 February 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 53-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 53,54,57-66 and 69-77 is/are rejected.
- 7) Claim(s) 55,56,67 and 68 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date Jan 04.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

1. This communication is in response to Amendment filed 02/25/05, claims 1-52 have been canceled and claim 53-77 have been added and remain pending.
2. Acknowledgment is made to claim priority under 35 U.S.C. §119 for the benefit of the earlier filing date with respect to Japanese Patent Application No. 2000-222814 filed July 24, 2000. A certified copy of the application has been received and placed in file.
3. Acknowledgment is made to Information Disclosure Statement (IDS) filed pursuant to 37 C.F.R. 1.97 and 1.98, filed on 1/16/04. Respective PTO-1449 has been considered and initialed.
4. Claims 55-56 and 67-68 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
5. Claim 58 is objected to a minor informality, reads, if the forwarding terminal is a facsimile apparatus conversion takes place, this is thereby, a condition limitation, raises uncertainties as to what happens when the terminal is not a facsimile apparatus.

Claim Rejection under 35 U.S.C. 103

6. Quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action may be found in previous office action.
7. Claims 53-54, 57, 60, 64-66, 69, 72, and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,092,114) SHAFFER et. al. (hereafter referred to as Shaffer) in view of (US 5,303,343) Ohya et. al. (hereafter referred to as Ohya).

Regarding claim 53, Shaffer teach an apparatus comprising:

reception means (12) for receiving transmission information addressed to a user (col 3/lines 63-col 4/line 4, step 40 of Fig. 2, col 6/lines 6-18 and col 8/lines 35-41) at a target terminal (col 5/lines 51-55);

determination means (12) for determining whether the transmission information is presentable at the target terminal (step 48 pf Fig. 2, col 6/lines 54-65);

conversion means (12) for converting the transmission information to be presentable at the forwarding terminal (step 52 of Fig. 2, col 6/line 66-col 7/line 6); and

control means (12) for controlling to send, i.e. transmitting the converted transmission information to the forwarding terminal (step 52 and 48 of Fig. 2); however Shaffer does not explicitly teach forwarding data to a different terminal from a target terminal when said data is not presentable at the target terminal.

Ohya suggests forwarding data to a terminal different than the target terminal when said data is not presentable at the target terminal, particularly, when said data is not presentable at the target terminal based on network conditions (col 5/lines 49-59), including teaching for determining when the data is not presentable at the target terminal, specifically, when the destination terminal cannot handle a data transmitted from the data originator terminal (col 2/lines 20-27).

It would have been obvious to one ordinary skilled in the art at the time the invention was made given the suggestions of Shaffer for determining whether information to be transmitted is displayable at the recipient or target client device, the teachings of Ohya for allowing transmission and reception of data between terminals determined to handling a predetermined media type, including different media would have been readily apparent. Motivation to combine the teachings of the references would be to determine where the transmitted information is presentable at the destination terminal, converting if need for transmission to the intended terminal or forwarding to an different terminal capable of handling transmitted information based on the attributes of the target device and based on the network conditions.

Regarding claim 54, a database which stores data indicative of presentation ability of a forwarding terminal, in the form of a table, used for making the above-mentioned determination (Ohya: Figs. 8-9).

Regarding claim 57, notification means for notifying the target terminal of a notification representing that the transmission information is forwarded to the forwarding terminal (Ohya: Figs. 10-11)

8. Claims 58-59, and 70-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer in view of Ohya in further view of US 5,881,233 TOYODA et. al. (Toyoda hereafter)

Regarding claim 58, however the above prior art does not explicitly teach the conversion into facsimile data;

Toyoda teaches means (5) to convert mail text data to a fax format (col 8/lines 3-10), image data in to fax format (col 1/lines 50-58), generating a cover sheet (col 3/lines 43-48).

It would have been obvious to one ordinary skilled in the art at the time the invention was made to include the teachings of Toyoda given the suggestions of Schaffer directed to message delivery systems and resource capabilities of devices in a business corporate environment, it would have been obvious to one ordinary skilled in the art to include fax machines as resource device present in this environment. Motivation to convert email and transmit to a fax would be redirect large document to fax machine diverting them from portable (low storage or displayable resource) terminals.

Regarding claim 59, comprises cover page generation means for generating cover page data representing an address of a data destination, and said providing means attaches cover page data to the facsimile data obtained (Toyoda: col 3/lines 43-48)

Regarding claim 60, although Schaffer suggests downloading transmission information from a web server including HTML documents, however it does not explicitly teach when destination is an apparatus web capable device the output data is accessible by a URL over the network.

Official Notice (see MPEP § 2144.03 Reliance on "Well Known" Prior Art) is taken that HTML document typically contain hyperlink having URLs embedded was old and well known in the Data Processing art. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include web information accessible via URLs over a network such as the Internet, because URL embedded document enable user to via one document access another document, audio, video or other multi-media information via a single click.

9. Claims 61 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer in view of US 6,629,130 MERTAMA et. al. (Mertama hereafter).

Regarding claim 61, Schaffer teaches designation conversion means, wherein said conversion means converts each of the parts so that each of the parts becomes appropriate for representation at the

forwarding terminal, which convert the transmission information in a format suitable for display by the recipient destination terminal (col 2/lines 30-65, col 8/lines 35-69), including text messages having attachments of different formats (col 1/lines 15-19); further including

identifying divided data or parts contained in the transmission information and their associated format (col 9/lines 60-64) and conversion such divided data or parts such that each part is in a suitable format displayable by the destination terminal , i.e. “integrating the respective data format-converted on the basis of the designation of said designation means” (col 9/line 65-col 10/line 15); however Schaffer does not teach division means for dividing the data contained in the transmission information;

Mertama teach a system/method related to electronic messaging system, wherein electronic mail server (11) (“division means”) divide the data contained in the transmission information (e.g. e-mail) into predefined structural parts, each part associated with a data type, e.g. mail text format (col 1/lines 15-55, col 6/lines 34-38, 41-56), where these different format parts require that the destination/receipt terminal has the capability to display them (col 1/lines 56-64) including portable terminals (col 3/lines 27-29).

It would have been obvious to one ordinary skilled in the art at the time the invention was made given to include Mertama’s teachings for dividing predefined structural parts in transmission information and converting if need by the destination terminal. Motivation would be to leave the attachment of a text mail message for transmission to the destination upon determination step if attachment part found to be displayable at the destination terminal.

10. Claims 62-63 and 74-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer in view of Mertama in further view of (US 5,859,967) Kaufeld et. al. (Kaufeld hereafter).

Regarding claims 62-63, however the above-mentioned prior art does not explicitly teach billing the user for conversion services performed.

Kaufeld teaches converting an email (“transmission information”) to a fax and transmitting the facsimile and charging for this service (col 5/lines 26-28); including charging for the format conversion service (col 11/lines 51-62).

It would have been obvious to one ordinary skilled in the art at the time the invention was made given the suggestions of Schaffer for conversion services being provide by service providers to subscriber, that billing procedures are typical in a provider-subscriber environment. Thereby, converting the transmission information based on a fee charged by converting processing would have been obvious. Motivation to combine these teachings would be given that Schaffer’s system includes a plurality of client

devices that may or may not have displaying limitations to implement a pay-as-you-use system, thereby accruing charges only when the conversion is performed.

Regarding claim 64, wherein the transmission information is an electronic mail (Schaffer: col 3/line 63-col 4/line 3).

Regarding claim 65, this claim comprises the method corresponding to apparatus of claim 53, same rationale of rejection is applicable.

Regarding claim 66, this claim is substantially the same as claim 54 discussed above, same rationale of rejection is applicable.

Regarding claims 69-71, 72-76, this claim is substantially the same as claims 57-71, 60-64 same rationale of rejection is applicable.

Regarding claim 77, this claim is the computer readable medium storing a control program causing a computer to execute an information providing apparatus of claim 53 and method of claim 65, discussed above, same rationale of rejection is applicable.

11. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Pertinent Prior Art:

13. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure; Copies of Non-Patent Literature documents cited will be provided (MPEP§ 707.05(a)):

US 6,104,711

Teaches routing to different destinations at different times, routing to an alternate destination if a primary destination is inactive, follow-me type service, etc. Several more specific routing examples will be discussed in detail later.

US 6,023,700

Teaches routing to different destinations, such as when the message receiver does not specify a preference for receiving the incoming message at the telecommunications service, the electronic mail distributor 14 based on other preferences or actions of the message receiver may forward the electronic message 16 to the receiver's mailbox 48 at the electronic mail service 10 or to one or more electronic mailboxes 50 designated for use by other members of the electronic mail service 10. Finally, the message 16 may be forwarded to Internet or another electronic mail service 52.

US 6,633,630

Teaches an inbound message options also allow a receiver (1) to be notified immediately of an inbound message and/or to redirect a message to an alternate device/address (i.e., perform an immediate action in response to the arrival of the message--immediate filter and forward options) or (2) to have messages stored in the original communication medium format or a second communication medium format for later retrieval (store and forward options.)

US 6,618,763

Teaches an intelligent information interconnect device can receive data in a first delivery format from a message originator including information used to identify a given wireless device, and can deliver the received data to a wireless device in a second delivery format that is independent of the first delivery format.

US 5,742,905

Teaches where if the subscriber's wireless terminal is not activated, e-mail messages may be automatically routed to alternate destinations as defined by the subscriber's profile, messages may also be routed to the subscriber's current serving network, which are to be sent to another network, and what media is to be used to receive certain messages. The subscriber may also designate, for example, that if the wireless terminal is off, all text messages are to be sent to e-mail and all voice messages are to be sent to voice mail.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (571) 272-3902. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see <http://pair-direct.uspto.gov> or the Electronic Business Center at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

or faxed to the Central Fax Office:

(703) 872-9306, for Official communications and entry;

Or Telephone:

(703) 306-5631 for TC 2100 Customer Service Office.

Beatriz Prieto
BEATRIZ PRIETO
PRIMARY EXAMINER

B. Prieto
TC 2100
Primary Examiner
June 8, 2005